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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,836	04/02/2004	Christian Galca	119339	8842
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EXAMINER				
DOUYON, LORNA M				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/815,836

Applicant(s)

GALEA, CHRISTIAN

Examiner

Lorna M. Douyon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/14/07; 11/9/07.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 and 25-28 is/are pending in the application.
- 4a) Of the above claim(s) 25-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 14, 2007 has been entered.
2. Claims 1-22, 25-28 are pending. Claims 25-28 are withdrawn as being drawn to non-elected claims.
3. The election by original presentation was traversed by Applicant and stated that the subject matter of all claims 25-28 is sufficiently related that a thorough search for the subject matter of any one of claims 1-22 would encompass a search for the subject matter of the remaining claims, and that the search and examination of the entire application could be made without serious burden.

This is not found persuasive because the inventions are independent or distinct for the reasons set forth in the previous office action and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification.

The requirement is still deemed proper and is therefore made FINAL.

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4. The rejection of claims 1 and 23 under 35 U.S.C. 103(a) as being unpatentable over Olson et al. (US Patent No. 6,472,027) is withdrawn in view of Applicant's amendment.

5. The rejection of claims 1-6 and 17 under 35 U.S.C. 103(a) as being unpatentable over Takayanagi et al. (US Patent No. 5,612,303) is withdrawn in view of Applicant's amendment.

6. The rejection of claims 1-22 and 24 under 35 U.S.C. 103(a) as being unpatentable over Lallier et al. (US Patent No. 6,656,896) in view of Olson or Takayanagi is withdrawn in view of Applicant's amendment.

Claim Rejections - 35 USC § 103

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 1-6, 9-13, 17, 20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takayanagi et al. (US Patent No. 5,612,303) in view of Olson et al. (US Patent No. 6,472,027), hereinafter "Olson".

Takayanagi teaches a solvent composition suitable for use as a solvent or an assistant in paints and varnishes, coatings, adhesives, printing inks, cleaning agents and cosmetics (see col. 1, lines 8-12), which comprises, as an active component, at

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least one oxyisobutyric acid ester (see col. 3, line 54+) in amount not less than 10% by weight and other organic solvents (see col. 5, lines 57-53), which is understood to be the remainder of the composition. The other solvents include, among others, isophorone, N-methyl pyrrolidone, dimethyl sulfoxide, benzyl acetate, propylene glycol monomethyl ether acetate (equivalent to methoxypropyl acetate) (see col. 5, line 54 to col. 6, line 20). Solvents which are particularly useful to provide a resist stripper include methyl ethyl ketone, N-methylpyrrolidone, dimethylformamide, dimethylacetamide, dimethyl sulfoxide, benzyl acetate, acetonitrile, γ -butyrolactone, propylene glycol monomethyl ether acetate (i.e. methoxypropyl acetate), diacetone alcohol, dimethylsuccinate, dimethyl glutarate, and dimethyl adipate, among others (see col. 9, line 52 to col. 10, line 22). The organic solvents may be used either individually or in combination of two or more thereof (see col. 10, lines 23-24). When used as a cleaning agent, the cleansing action of the solvent composition may be improved, if desired, by using a surface active agent such as nonionic surface active agent (see col. 11, lines 5-8), which also reads on dispersant, an anionic surface active agent, or a cationic surface active agent (e.g., long chain amines and quaternary ammonium salts), an acidic, or a basic compound in combination (see col. 11, lines 9-16). Typical example of the basic compound includes triethanolamine (see col. 11, lines 19-21). The surface active agent, acidic compound and basic compound is preferably used in an amount of from 0.01 to 30% by weight based on the total solvent composition (see col. 11, lines 21-24). In one example, benzyl acetate is used in an amount of 30 wt% (see col. 18, line 23), and in another, 20 wt% (see col. 18, line 62). In one example, propylene glycol monomethyl

ether acetate (i.e., methoxypropyl acetate) is used in an amount of 10 wt% and dimethyl succinate at 10 wt% (see col. 16, last line and col. 17, lines 8-9). The resist strippers shown in Table 17 and most of the solvents shown in Table 9 do not require water as the solvent. Takayanagi, however, fails to specifically disclose a solvent composition comprising benzyl acetate and at least one of diacetone alcohol, isophorone and methyl ethyl ketone, N-methyl pyrrolidone or dimethyl sulfoxide in their recited amounts, the composition being devoid of water, and the composition in the form of a gel or cream.

Olson, an analogous art, teaches a stripper composition which contains a polar solvent, and suitable polar solvents include, among others, benzyl acetate, diacetone alcohol, isophorone and methyl ethyl ketone (see col. 3, lines 46-55, line 59; col. 4, lines 5-6 and 15). The stripper composition contains up to about 5 wt% adjuvants (e.g., thickeners) (see col. 4, lines 40-45).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare a solvent composition comprising benzyl acetate, diacetone alcohol, isophorone and/or methyl ethyl ketone, N-methyl pyrrolidone or dimethyl sulfoxide, and no water because Takayanagi teaches in col. 10, lines 23-24 that the organic solvents can be used in combination and that water need not be present in the compositions. With respect to their individual proportions, it would have been obvious to one of ordinary skill in the art at the time the invention was made to select the portion of the prior art's range which is within the range of applicant's claims because it has been held to be obvious to select a value in a known range by optimization for the best results. As to optimization results, a patent will not be granted

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based upon the optimization of result effective variables when the optimization is obtained through routine experimentation unless there is a showing of unexpected results which properly rebuts the *prima facie* case of obviousness. See *In re Boesch*, 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980). See also *In re Woodruff*, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936-37 (Fed. Cir. 1990), and *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

In addition, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate up to about 5% by weight of thickeners into the solvent composition of Takayanagi because this would provide for a greater diffusion rate of the stripper composition through the cured finish as taught by Olson in col. 4, lines 35-40.

9. Claims 7-8, 14-19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takayanagi and Olson as applied to the above claims, and further in view of Lallier et al. (US Patent No. 6,656,896), hereinafter "Lallier".

Takayanagi and Olson teach the features as described above. Takayanagi and Olson, however, fail to disclose diethanolamine, inorganic fillers like calcium carbonate, calcium hydroxide, clay, bentonite, and the recited cellulose thickener.

Lallier, an analogous art, teaches a stripping composition suitable for stripping external organic coatings which contains 0.3 to 10 parts by weight of a combination of softening agents (see abstract) which includes an ethanolamine such as diethanolamine (see col. 1, lines 58-64). The stripping composition can additionally comprise, per 100

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parts by weight of the stripping composition, at least one inorganic filler with a thickening nature, in a proportion of 20 to 60 parts by weight, for example, calcium carbonate, calcium phosphate, calcium hydroxide, clay or bentonite; and/or at least one cellulose thickener, in a proportion of 0.05 to 1.5 parts by weight, for example, hydroxypropyl methyl cellulose ether; and/or dispersing agent, in a proportion of 0.1 to 10 parts by weight, for example, the acidic phosphoric ester of 2-ethylhexanol (see col. 2, lines 1-35).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the triethanolamine of Takayanagi and Olson with its homologues, i.e., diethanolamine because characteristics normally possessed by members of homologous series are principally the *same*, and vary but gradually from member to member; chemists knowing properties of one member of series would in general know what to expect in adjacent member, see *In re Henze*, 85 USPQ 261.

It would also have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate inorganic fillers like calcium carbonate, calcium phosphate, calcium hydroxide, clay or bentonite in their optimum proportions because this would provide dry strips product, which is easily removed with a scraper, when the stripping composition is applied to the coating, as taught by Lallier.

It would also have been obvious to one of ordinary skill in the art at the time the invention was made to have utilized hydroxypropyl methyl cellulose ether as the specific thickener in the composition of Takayanagi and Olson because it is a known thickener for stripping as shown by from Lallier.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references are considered cumulative to or less material than those discussed above.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lorna M. Douyon whose telephone number is 571-272-1313. The examiner can normally be reached on Mondays-Fridays 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000

/Lorna M. Douyon/
Primary Examiner
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